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Docket No.: 085804 . 013500

Appl. No.: 09/916,543  
Response To Office Action Filed With RCE

DEC 15 2006

REMARKS

Claims 1, 2, 4, 7 to 17, 20 to 77, 79, 80, 82 to 108 and 110 to 124 are the pending claims, of which Claims 1, 11, 16, 24, 29, 31, 75, 107, 108, 111 and 112 are the independent claims. Reconsideration and further examination are respectfully requested.

By the Office Action, the claims are rejected under 35 U.S.C. § 103(a). More particularly, Claims 1, 16, 29, 75, 107 and 108 are rejected over U.S. Patent No. 6,125,385 (Wies) and U.S. Patent No. 6,337,696 (Lindhorst), Claims 2, 4, 9 to 13, 17, 22 to 26, 30 to 74, 76, 77, 79, 80, 82, 85 to 106 and 110 to 124 are rejected over Wies, Lindhorst, and U.S. Patent No. 5,996,003 (Namikata), Claims 7, 8, 20, 21, 83 and 84 are rejected over Wies, Lindhorst, Namikata and U.S. Patent No. 5,708,780 (Levergood), and Claims 14, 15, 27 and 28 are rejected over Wies, Lindhorst, Namikata and U.S. Patent No. 6,128,649 (Smith). Reconsideration and withdrawal of the rejection are respectfully requested.

Turning to the specific language of the claims, Claim 1 recites a method of adding interactive functionality to a web-page. According to the method, a request for the web-page is received from a first user. The requested web-page is retrieved, and script code is embedded within the requested web-page to add interactive functionality to the web-page. The step of embedding the script code is performed absent user editing and comprises parsing the requested web-page to determine an appropriate location to embed script code that is absent from the requested web page prior to the parsing. The requested web-page having the embedded script code is transmitted to the first user.

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In accordance with the method of Claim 1, the step of embedding the script code parses a requested page to determine an appropriate location to embed script code that is absent from the requested web page prior to the parsing and embed the script code within the requested web page. As recited in Claim 1, embedding the script code is performed absent user editing.

At page 2, the Examiner indicates that she is interpreting the "absent user editing" language to mean that the embedding and parsing are performed by software. The Examiner alleges that there is no "antecedent basis" in the specification for the claim language, and requests that Applicant identify the support for the language found in the present application. In addition, the Examiner cites MPEP § 2173.05(i) and indicates that "any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement."

In response, as an example of some portions of the present application that provide support for the referenced claim language, Applicants respectfully refer the Examiner to Figure 4, and the corresponding description commencing at paragraph 35 (paragraph references are based on the numbering used in the published application), of the present application. As is described in the detailed description and shown in steps 804, 806, 808, 810 and 812 of Figure 4, in response to receiving a request for a web page from a user, a server retrieves the web page, parses the web page to identify a location to add script code, adds the script code to the web page at the identified location, and transmits the web page to the user.

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It is clear from the description, and the Examiner is correct, that the steps are performed using code executing on a computer. As can also be seen from the referenced portions of the present application, in accordance with at least one disclosed embodiment, software executing on a server performs steps of parsing a web page and embedding script code into the web page, not a user. The user requests the web page and receives the web page with the script code embedded in the web page. The web page is modified by the code executing on the server, not by the user. It is clear from the description provided in the present application that the user does not perform any editing on the web page, and that there is indeed no need for editing on the part of the user.

The absence of user editing to embed the script code in a web page is also supported by the illustrative examples of ways in which the embedded script code is used to add functionality. By way of just one non-limiting example, the script code is embedded into a web page used in an educational setting by a teacher and her students. The embedded script code adds functionality to the web page to allow the teacher to make markings in the displayed text of a text book, which markings are then communicated to each of the student's displayed textbook text, so that the students are able to receive real-time, interactive instruction over the Internet, and without the need for specialized or expensive hardware. If it was necessary for the teacher and each of the students to receive the web page and perform editing to embed the script code into the received web page, it would have most certainly been described in the present application.

Reference is respectfully made to *Ex parte Parks*, 30 USPQ 1234 (Bd. Pat. App. & Int. 1193), which is cited in MPEP § 2173.05(i). In addressing the question of adequate descriptive support under 35 U.S.C. § 112, first paragraph, the Board concludes that there is no literal

requirement under 35 U.S.C. 112, first paragraph, and states, at page 1236:

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[t]he examiner contends that the rejected claims lack adequate descriptive support because there is "no literal basis for the claim limitation "in the absence of a catalyst." Clearly, the observation of a lack of literal support does not, in and of itself, establish a *prima facie* case for lack of adequate descriptive support under the first paragraph of 35 U.S.C. § 112. [citations omitted]

The Board referred to *Ex parte Graselli*, 231 USPQ 393 (Bd. Pat. App. & Int. 1983), which was cited in the Office Action, noted that the decision therein was based on the particular facts of that case, and then held that:

[i]n the situation before us, it cannot be said that the originally-filed disclosure would not have conveyed to one having ordinary skill in the art that appellants had possession of the *concept* of conducting the decomposition step generating nitric acid in the absence of a catalyst. See, for example, column 5 of the '562 patent, first paragraph, wherein FIG. 4 is discussed. Pyrolysis temperatures of between 600 degrees C and 700 degrees C, and above 700 degrees C were employed to achieve conversion of chemically bound nitrogen to nitric oxide. Smooth conversion was obtained above 700 degrees C, while the optimum conversion was found to occur above 900 degrees C. Throughout the discussion which would seem to cry out for a catalyst if one were used, no mention is made of a catalyst. *Id.*

In the present case, as was concluded by Board in *Ex Parte Parks*, it cannot be said that the originally-filed disclosure would not have conveyed to one having ordinary skill in the art the concept of performing an embedding step absent user editing. It can only be said that there is clear and ample descriptive support for the "absent user editing" claim language under 35 U.S.C. § 112, first paragraph.

Turning to the art rejections, in response to Applicants' previous remarks, the Examiner refers to Lindhorst's ability to insert new script code, and contends that new script code is inserted without editing the script code. This position ignores the fact that editing is performed by the user regardless of whether the script code is new or existing code, and that the new script code cannot be inserted without editing performed by the user. Reference is respectfully made to

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step 106 of Figure 3 of Lindhorst, which describes the process by which the user edits a document, and can add new script code to the document in editing document. Step 106 of Figure 3 opens the document for editing by the user. As part of editing the web page, the user performs an editing operation, in steps 124 to 130, which results in new script code being generated, at step 140. Prior to the completion of the editing process, the document is rebuilt to include the script code, at step 150. If it is assumed, arguendo, that the step 150 of Figure 3 corresponds to embedding script code (an assumption that is in no way conceded), it certainly cannot be said that the embedding of script code is performed absent user editing. The script code, new or existing, is inserted into the document at step 150 of Lindhorst as an integral part of the editing performed by the user.

The Examiner's response refers to Figure 5 and Figure 8 of Lindhorst, both of which show steps performed as part of the editing process described in Lindhorst. As is described at col. 3, lines 55 to 67 of Lindhorst, Figure 5 shows the parsing process performed at the beginning of the editing process, at step 106 shown of Figure 3, and Figure 8 shows the document reconstruction process performed at the end of the editing process, at step 150 of Figure 3. The parsing and the document reconstruction shown in Figures 5 and 8, respectively, cannot be said to be performed absent user editing.

Furthermore, it cannot be said that the parsing performed in Lindhorst corresponds to the parsing performed as part of the claimed embedding step. The parsing performed in Lindhorst is performed as part of document editing, and the editing process shown in Figure 3 of Lindhorst. More particularly, with reference to steps 106 and 110 of Figure 3 of Lindhorst, the editing process opens the document and parses the document for editing by the user. Figure 5 of

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Lindhorst provides the detailed steps of the parsing referred to in step 110 of Figure 3. As is clear from Lindhorst, document parsing is performed as part of the editing process described in Lindhorst, and cannot be said to in any way correspond to the claimed parsing which is part of an embedding step performed absent user editing.

The Office Action concedes that Weis fails to disclose or suggest parsing a web-page to determine an appropriate location to embed the script code. In light of the concessions made in the Office Action, Weis cannot be said to disclose or suggest performing the step of embedding script code absent user editing by parsing the web page to determine an appropriate location to embed the script code. Furthermore and as discussed below, Lindhorst fails to disclose embedding script code within a requested web page prior to transmitting the web-page to a requesting user, the step of embedding the script code being performed absent user editing by parsing the requested web page to determine an appropriate location to embed script code that is absent from the requested web page prior to said parsing.

At page 4, the Office Action states that:

[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made given the suggestions [in] Weis for enhancing interactive functionalities on web pages [to incorporate] the teachings of Lindhorst implementing a user interface for creating/editing these interactive functionalities on a web pages [sic]. One would be motivate [sic] to incorporate Lindhorst teachings into [sic] enable one without extreme complexity, writing a single line of code or extensive programming knowledge or the syntax thereof to implement the enhancement, taught by Wies.

The Examiner's own grounds for rejection concede that Lindhorst describes an environment for editing a document to add code to the document.

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Even while the above should be sufficient reason to withdraw the rejection of the 35 U.S.C. 103(a) rejection of the claims, it is further submitted that there is no suggestion for the proposed hypothetical combination. Weis focuses on an environment to provide sensory feedback to a user by transmitting a web page to the user's computer, the web page containing objects to control operation of force feedback devices to provide the sensory feedback to the user. In contrast, Lindhorst describes an editing/development environment in which a user can edit an HTML object/document. The two environments are not at all compatible, and neither provide a suggestion, motivation or teaching to combine, let alone to make the hypothetical combination suggested in the Office Action. It is further submitted that any hypothetical combination of Weis and Lindhorst would result in rendering one, or the other or both inoperable for their intended purpose.

The cited portions of Namikata have been reviewed and are not seen to remedy the deficiencies noted above.

Claims 1, 11, 16, 24, 29, 31 (and the claims that depend therefrom) are therefore believed to be in condition for allowance. In addition, for at least the same reasons, Claims 75, 107, 108, 111 and 112 (and the claims that depend therefrom) are believed to be in condition for allowance.

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In view of the foregoing, the entire application is believed to be in condition for allowance, and such action is respectfully requested at the Examiner's earliest convenience. The Applicant respectfully requests that a timely Notice of Allowance therefore be issued in this case. Should matters remain which the Examiner believes could be resolved in a further telephone interview, the Examiner is requested to telephone the Applicant's undersigned attorney.

In this regard, Applicant's undersigned attorney may be reached by phone in California (Pacific Standard Time) at (714) 708-6500. All correspondence should continue to be directed to the below-listed address.

The Commissioner is hereby authorized to charge any required fee in connection with the submission of this paper, any additional fees which may be required, now or in the future, or credit any overpayment to Account No. 50-2638. Please ensure that the Attorney Docket Number is referred when charging any payments or credits for this case.

Respectfully submitted,



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